

Application No. 09/869,638

Filed: February 8, 2002

TC Art Unit: 2624

Confirmation No.: 5891

REMARKS

Claim 1 has been amended. Claims 3, 4, 10, 12, and 14 were previously canceled. Claims 1, 2, 5-9, 11, 13, and 15 are pending.

The amendment of claim 1 adds the requirement that "at least one said bleaching procedure is performed". Support is found in the specification as filed, for example, in the paragraph beginning at page 6, line 21. This paragraph describes an embodiment in which a bleaching step is carried out between recording each pair of consecutive images. In particular, the paragraph states that "the process comprising marking, image generation and bleaching can be repeated with up to nine markers." Clearly, a method employing nine different markers requires at least one bleaching step.

Claims 1, 2, 5-9, 11, 13, and 15 are rejected for alleged obviousness over Luck et al. in view of Watanabe and Hemstreet. These rejections are respectfully traversed for the reasons given below, and reconsideration is requested.

Rejection Under 35 U.S.C. § 103(a)

Claims 1, 2, 5-9, 11, 13 and 15 are rejected as allegedly obvious over Luck in view of Watanabe and Hemstreet.

In response to the previous Office Action, Applicants argued that the claims as then amended were not obvious over the cited references because the references, either singly or combined, failed to teach or suggest using a plurality of different chemical markers to label the same biological objects with different markers in at least two microscope images. The current Office Action has again rejected the claims based on a combination of the

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same three references. The Office Action maintains that the claims as previously amended read on a double labeling technique as disclosed by Hemstreet, in which a first stain is applied, the specimen is rinsed, and a second stain is applied.

The claims as previously amended require that "a bleaching or rinsing procedure is performed between taking an image and taking the next image". The present amendment adds the requirement that at least one said bleaching procedure is performed. The double staining technique taught by Hemstreet does not involve bleaching. The entire point of such a double staining procedure is to produce an image with contributions from both stains, which would be inconsistent with performing a bleaching procedure between stains.

None of the references cited, either alone or in combination, teaches or suggests obtaining two or more microscope images of biological objects with the use of different chemical markers for each image and rinsing or bleaching between applying such markers, wherein at least one bleaching procedure is performed. Therefore, because the cited references do not teach or suggest every claim limitation, the references do not support a *prima facie* case of obviousness.

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The Examiner is encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

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